

ESTTA Tracking number: **ESTTA442634**

Filing date: **11/22/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	R. Josephs Licensing Inc.
Granted to Date of previous extension	11/26/2011
Address	16350 Ventura Boulevard, Suite 447 Encino, CA 91436-5315 UNITED STATES
Attorney information	Timothy T. Tyson Leon D. Rosen & Associates, P.C. 10960 Wilshire Boulevard Suite 1220 Los Angeles, CA 90024-3714 UNITED STATES l.rosen@prodigy.net Phone:310-477-0478

### Applicant Information

Application No	85314605	Publication date	09/27/2011
Opposition Filing Date	11/22/2011	Opposition Period Ends	11/26/2011
Applicant	Laguna Fitness, Inc. 30025 Alicia Parkway #214 Laguna Niguel, CA 92677 UNITED STATES		

### Goods/Services Affected by Opposition

Class 025. First Use: 2004/01/28 First Use In Commerce: 2004/01/28  
All goods and services in the class are opposed, namely: Sports bras; Sports jerseys; Sports pants; Sports shirts; Sports shirts with short sleeves; Surf wear; Swim wear; Swim wear for gentlemen and ladies; Swimwear; Women's clothing, namely, shirts, dresses, skirts, blouses

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Trademark Act section 1(a)1 37 CFR section 2.34(a)(1)(iv) TMEP section 904 37 CFR section 2.34(a)(1)(i) TMEP section 806.01(a)

### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1541125	Application Date	12/22/1987
Registration Date	05/30/1989	Foreign Priority	NONE

		Date	
Word Mark	LAGUNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 1987/12/21 First Use In Commerce: 1987/12/21 [ SUNTAN LOTIONS; BODY OILS ]</p> <p>Class 009. First use: First Use: 1987/12/21 First Use In Commerce: 1987/12/21 [ SUNGLASSES ]</p> <p>Class 018. First use: First Use: 1987/12/21 First Use In Commerce: 1987/12/21 [ WOMEN'S HAND BAGS; DUFFEL BAGS, FABRIC TOTE BAGS, AND FABRIC SIDED LUGGAGE ]</p> <p>Class 024. First use: First Use: 1985/00/00 First Use In Commerce: 1985/00/00 [ TOWELS ]</p> <p>Class 025. First use: First Use: 1946/02/01 First Use In Commerce: 1946/02/01 MEN'S, AND BOYS', [ JUVENILE BOYS' ] CLOTHING, namely, SWIM SUITS, SWIM WEAR, SPORT SHIRTS, [ WARM-UP SUITS, ] T-SHIRTS, [ JACKETS, SUITS, SPORTCOATS, ] UNDERWEAR, [ BELTS, HATS, ] SHOES, [ TIES, AND PAJAMAS; ] WOMEN'S, AND GIRLS', [ JUVENILE GIRLS' ] CLOTHING, namely, [ BLOUSES, SKIRTS, JACKETS, JOGGING SUITS, ] SHORTS, PANTS, JEANS, [ SOCKS, BELTS, SWIM SUITS, SWIM WEAR, HATS, UNDERWEAR, SLEEPWEAR, AND PAJAMAS ]</p>		

Attachments	laguna1.pdf ( 8 pages )(350454 bytes ) laguna2.pdf ( 1 page )(251728 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Timothy T. Tyson/
Name	Timothy T. Tyson
Date	11/22/2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF the Trademark Application of Laguna Fitness, Inc.  
For Registration of LAGUNA FITNESS, Serial No. 85314605  
Published for Opposition in the Official Gazette on 09/27/2011

R. JOSEPHS LICENSING INC.,	)	Opposition To
a California corporation,	)	
	)	Registration of Mark
Opposer,	)	
	)	
vs.	)	
	)	
LAGUNA FITNESS, INC.,	)	
a California corporation,	)	
	)	
Applicant.	)	
_____	)	

R. Josephs Licensing Inc., a corporation duly organized and existing under the laws of the State of California, and having its principal place of business at 16350 Ventura Boulevard, Suite 447, Encino, California 91436-5315 believes that it will be damaged by registration of the mark shown in Application Serial No. 85/314,605, and hereby opposes the same.

As grounds for opposition. it is alleged that:

GROUND 1, TRADEMARK ACT §2(d)

1. Opposer and its predecessors in interest began selling clothing in interstate commerce since at least as early as 1946 under the LAGUNA trademark.
2. Opposer has continuously sold clothing from 1946 to date under the LAGUNA Trademark.
3. Opposer's products are sold under the LAGUNA trademark in all 50 states.
4. Opposer has, by virtue of its extensive usage, advertising, and promotion, built up a high level of consumer and trade recognition symbolized by the LAGUNA trademark. Due to the extensive public exposure to, and awareness by, consumers and the trade, the LAGUNA trademark has acquired and now possesses an extremely favorable reputation and distinctiveness, with an invaluable amount of goodwill, solely signifying Opposer as the source of clothing.
5. Opposer is the owner of U.S. Trademark Registration Number 1541125, issued March 7, 1989, for the mark LAGUNA in class 25 for MEN'S, AND BOYS' CLOTHING, NAMELY SWIM SUITS, SWIM WEAR, SPORT SHIRTS, T-SHIRTS, UNDERWEAR, SHOES; WOMEN'S, AND GIRLS' CLOTHING, NAMELY SHORTS, PANTS, AND JEANS, which registration is incontestible pursuant to Section 15 of the Lanham Act (Title 35, United States Code, §1065). Said registration was based on an application filed in the U.S. Patent and Trademark Office on

December 22, 1987, which is a date prior to the date of first use and first use in commerce by Applicant. Said registered mark of Opposer is valid and subsisting and is conclusive evidence of Opposer's exclusive right to use said mark in commerce on the goods specified in said registration.

6. On May 6, 2011, Applicant filed a trademark application for registration of the mark LAGUNA FITNESS for Sports bras; Sports jerseys; Sports pants; Sports shirts; Sports shirts with short sleeves; Surf wear; Swim wear; Swim wear for gentlemen and ladies; Swimwear; Women's clothing, namely, shirts, dressed skirts, blouses in International Trademark Class 025 alleging a date of first use of January 28, 2004, and a date of first in commerce on January 28 2004.

7. The customers most interested in such goods are young. They are precisely the kinds of customers who seek out and purchase Opposer's goods.

8. Applicant's LAGUNA FITNESS mark incorporates in its entirety Opposer's mark LAGUNA. Applicant's LAGUNA FITNESS mark and Opposer's LAGUNA mark are so similar that when applied to their respective goods there is a likelihood of confusion, mistake, or deception in that purchasers will erroneously believe the Applicant's goods either originate with, or are sponsored, approved, or licensed by, or are in some way legitimately connected

with Opposer.

9. Registration of the mark sought to be registered by Applicant is barred by the provisions of Section 2(d) of the Lanham Act (Title 15, United States Code, §1052(d)) for the reason that it consists of or comprises a mark which so resembles a mark previously registered in the Patent and Trademark Office and a mark previously used by Opposer and not abandoned, as to be likely, when applied to the goods of the Applicant, to cause confusion or to cause mistake, or to deceive.

GROUND 2 - TRADEMARK ACT §1(a)1

TITLE 37, CODE OF FEDERAL REGULATIONS §2.34(a)(1)(iv)

TRADEMARK MANUAL OF EXAMINING PROCEDURE §904

10. Applicant is applying for use on Sports bras; Sports jerseys; Sports pants; Sports shirts; Sports shirts with short sleeves; Surf wear; Swim wear; Swim wear for gentlemen and ladies; Swimwear; Women's clothing, namely, shirts, dresses, skirts, blouses in International Trademark Class 025.

11. But in Applicant's application, Applicant admits that "The applicant is submitting one specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Specimen shows use of name, marks on website, page content and page footer." An

examination of the specimen provided by Applicant clearly shows that it is a website. The mark is in the URL (universal resource locator) for the website, the title of the website, in the page content of the website, and the footer of the website. This is not use on the goods that are the subject of the application.

12. On information and belief, Opposer alleges that the labels and hang tags on the goods that are the subject of the application have the mark UJENA and not the mark LAGUNA FITNESS, as shown in the attached Exhibit A.

13. Registration of the mark sought to be registered by Applicant is barred by the provisions of §1(a)(1) of the Lanham Act (Title 15, United States Code, §1051(a)(1)) for the reason that "The owner of a trademark used in commerce may request registration of its trademark by . . . filing . . . such number of specimens or facsimilies of the mark as used as may be required by the Director." Title 15, United States Code, §1127, defines use in commerce: "The term 'use in commerce' means the bona fide use of a mark in the ordinary course of trade . . . (1) on goods when - (A) it is placed in any manner on the goods . . . or on the tags or labels affixed thereto . . ."

14. Registration of the mark sought to be registered by Applicant is barred by the provisions of Code of Federal Regulations §2.34(a)(1)(iv) for the reason that "(a) The application must

include . . . (1) Use in commerce under section 1(a) of the Act. . .  
. (iv) One specimen showing how the applicant actually uses the  
mark in commerce." Title 15, United States Code, §1127, defines  
use in commerce: "The term 'use in commerce' means the bona fide  
use of a mark in the ordinary course of trade . . . (1) on goods  
when - (A) it is placed in any manner on the goods . . . or on the  
tags or labels affixed thereto . . ."

15. Registration of the mark sought to be registered by Applicant  
is barred by the provisions of the Manual of Trademark Examining  
Procedure §904 for the reason that "Specimens are required because  
they show the manner in which the mark is seen by the public. . .  
An application for registration under §1(a) of the Trademark Act  
must include one specimen . . . showing use of the mark on or in  
connection with the goods. . . in commerce. . . If an application  
under §1(a) is filed without a specimen, the examining attorney  
must issue an Office action requiring the applicant to submit one  
specimen . . . , with an affidavit or declaration under 37 C.F.R.  
§2.20 stating that the specimen was in use in commerce on the  
filing date of the application. The Office action must also  
indicate that, pending submission of an acceptable specimen,  
registration is refused because the applicant has not provided  
evidence of use of the mark in commerce." Title 15, United States  
Code, §1127, defines use in commerce: "The term 'use in commerce'



means the bona fide use of a mark in the ordinary course of trade . . . (1) on goods when - (A) it is placed in any manner on the goods . . . or on the tags or labels affixed thereto . . ."

### GROUND 3

TITLE 37, CODE OF FEDERAL REGULATIONS §2.34(a)(1)(i)

TRADEMARK MANUAL OF EXAMINING PROCEDURE §806.01(a)

16. Applicant is applying for use on Sports bras; Sports jerseys; Sports pants; Sports shirts; Sports shirts with short sleeves; Surf wear; Swim wear; Swim wear for gentlemen and ladies; Swimwear; Women's clothing, namely, shirts, dresses, skirts, blouses in International Trademark Class 025.

17. But in Applicant's specimen, he does not show any use on Sports bras and Swim wear for gentlemen.

18. Registration of the mark sought to be registered by Applicant is barred by the provisions of Code of Federal Regulations §2.34(a)(1)(i) for the reason that "(a) The application must include . . . (1) Use in commerce under section 1(a) of the Act. . . (i) The trademark owner's verified statement that the mark is in use in commerce on or in connection with the goods . . . listed in the application." The verification is therefore false and the application must be barred.

19. Registration of the mark sought to be registered by Applicant is barred by the provisions of the Manual of Trademark Examining Procedure §806.01(a) for the reason that "An applicant may not claim a §1(a) basis unless the mark was in use in commerce on or in connection with *all* the goods . . . covered by the §1(a) basis as of the application filing date." The italics are in the original.

WHEREFORE, registration of the applied for mark would be damaging to Opposer, and Opposer prays that said application Serial Number 85314605 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Leon D. Rosen & Associates, P.C.

Dated: November 22, 2010

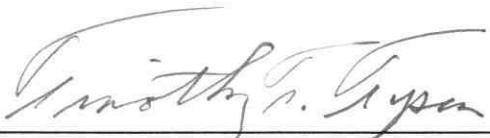
By   
Timothy T. Tyson  
Leon D. Rosen & Associates, Inc.  
Suite 1220  
10960 Wilshire Boulevard  
Los Angeles, CA 90024-3714  
(310) 477-0578  
Attorneys for Opposer  
R. Josephs Licensing Inc.



Exhibit A